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In re Application of:

Sul, Young-Taek

Serial No.: 10/550,197

Filed: Sep. 21, 2005

Docket: P57672

Title: HELICAL IMPLANT

DECISION ON PETITION
SEEKING REVERSAL OF
OBJECTION TO DRAWINGS

This is a decision on the petition filed on May 14, 2007 seeking reversal of the objection to the drawings. The petition is being considered pursuant to 37 CFR 1.181. No fee is required.

The petition is **DISMISSED**.

In the petition, petitioner requests review of the examiner's objection to the drawings under MPEP 608.02(g). The examiner objected to the drawings for failing to designate by a legend such as "prior art" next to Figs. 6-8. Petitioner believes that the objection to the drawings is in error and requests the drawing objection be withdrawn.

The record shows that:

In the non-final Office action of Aug. 4, 2006 and again in the final Office action of Apr. 10, 2007, the examiner requested that applicant to designate by a legend such as "Prior Art" next to Figs. 6-8. The applicant refused to do so because the applicant believes that Figures 6-8 are not "Prior Art". On May 14, 2007, the current petition was filed to request withdrawal of the drawing objection. In the petition, petitioner presented four arguments, which will be addressed in this decision.

Discussion and Analysis

Under the heading of "Description of the Related Art" on pages 1-3 of the specification, the applicant explained Fig. 6 -8 as a conventional helical implant. The following relevant passages have been reproduced from page 2 of the specification.

" Fig. 6 is an enlarged view showing thread inclines of a conventional implant. Although various modifications in construction of the implant are well known in the art, a helical implant formed with threads 10b on the outer surface thereof is generally used in the art. As shown in the figure, according to the conventional helical implant, the threads 10b have thread inclines 10a, each having a fiat surface, to which surface preparation is not applied, and the thread inclines 10a of two adjacent threads 10b form an inclined angle of thread of approximately 60*.

Fig. 7 is a vertical sectional view of the conventional implant and Fig 8 is a traverse sectional view of the conventional implant showing and example of the conventional implant disclosed in EP 1992 0 850 168."

First, petitioner argues that the term "prior art" is defined by statute not by the MPEP. Specifically, petitioner states nothing in any paragraph of § 102 sets forth that subject matter "which is old" constitutes prior art, as asserted by the Examiner. Petitioner also argues the age of the subject matter does not convert that subject matter into prior art, as the term "Prior Art" is defined by the law of the United States. Consequently, the Examiner's sole rational for imposing the requirement that Figs. 6-8 be labeled as "Prior Art" is contrary to statute and improper.

In response to this first argument, according to the Webster dictionary, "conventional" means "lacking originality," or put another way in accordance with U.S. patent intellectual property jargon, it is a reflection that whatever lacks originality is old. Thus, if applicant says something is "conventional", this means it is old. The statement is an admission. As noted in the admitted prior art material in MPEP 2129¹, admitted prior art may be used for purposes of anticipation and obviousness regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. One may argue that Fig. 6 is not a printed publication, or known to others, etc. (i.e., does not fall into any of the paragraphs in 35 U.S.C. 102), but the Examiner may still use it to make a rejection if applicant has stated that the referenced admission is old, i.e., "conventional". Under the MPEP 2129 and applicable case law, the Examiner has treated Fig. 6 as the work of another and is treatable as prior art to applicant as well. Therefore, Fig. 6 is considered to be "Prior Art". Petitioner, it is noted, did not dispute this presumption that Fig. 6 is the work of another.

With regard to Figs. 7 and 8, based on the above passage from page 2 of the specification, the applicant references a 1992 disclosure therein and surely that is prior art in accordance with MPEP 2129 II.² No discussion of these drawings is further provided under the detailed description of the preferred embodiments. Therefore, Figs. 7 and 8 are considered to be "Prior Art" because undoubtedly EP 1992 0850168 is a publication and is a form of "Prior Art". Also,

¹ MPEP 2129 (I) Admissions as Prior Art I. ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int 'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work."). Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

² MPEP 2129 II. DISCUSSION OF PRIOR ART IN SPECIFICATION Where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement).

the claims as originally filed define "A helical implant formed with threads thereon...". Figs 7 - 8 do illustrate the same conventional helical implant which formed with threads thereon that are the preamble for the claims. This illustrates that the applicant designated "conventional implants" as an admission of prior art in accordance with MPEP 2129 III³. Therefore, Figs. 7 and 8 are considered to be implied "Prior Art" as a matter of law. In the case Sjolund v. Musland, 6 USPQ2d 2020 (Fed. Cir. 1988), the Court held "It was uncontroverted that many relevant devices were old and the jury must have accepted their status as prior art. The first of these devices is the conventional king crab trap. The description of the prior art in the '071 patent states that "[c]onventional crab traps have been used in their present form for many years." This same trap is defined in the preamble of claim 1, which is a Jepson claim. Since the preamble of a Jepson claim is impliedly admitted to be prior art, see Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed.Cir. 1985); Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 649-50, 223 USPQ 1168, 1172 (Fed.Cir. 1984); In re Ehrreich, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979), and the specification confirms this implied admission, the jury must have accepted the conventional trap as prior art, as a matter of law. Here, this applicant clearly admits, under the heading "description of related art" (page 2 of the specification), Figs. 6-8 illustrate a conventional helical implant and defined in the preamble of the original claim 1. In view of the totality of the original specification and original claims, Figs. 6-8 constitute "Prior Art".

Second, petitioner argues that Figures 6-8 are not themselves believed to constitute "Prior Art" as that term is defined by either 35 U.S.C. § 102 or 35 U.S.C. § 103. The Examiner has introduced no evidence into the record of this application which would either contradict the applicant's belief or establish that Figures 6-8 constitute prior art, as that term is defined by 35 U.S.C. §103(a) of the statute, by its reference to § 102 of the statute. The argument is not persuasive. Nowhere in the specification does the applicant disclose the origin of the subject matter of Fig. 6. In absence of another credible explanation by the applicant, the examiners treated the subject matter of Fig. 6 as the work of another. Therefore, Fig. 6 is deemed to be "Prior Art". With regard to Figs. 7 and 8, based on the above passage from page 2 of the specification, the applicant references a 1992 disclosure EP 1992 0850168 which is prior art in accordance with MPEP 2129 II and as discussed above. Therefore, Figs. 7 and 8 are considered to be "prior art".

Third, petitioner argues that Figures 6-8 are simply abstract representations of the art prepared by the applicant in an effort to illustrate applicant's discovery of problems plagued in the art in accordance with 37 C.F.R. § 1.83(b); this discovery is itself, together with Applicant's

³ MPEP 2129 III. JEPSON CLAIMS Drafting a claim in Jepson format (i.e., the format described in 37 CFR 1.75(e); see MPEP § 608.01(m)) is taken as an implied admission that the subject matter of the preamble is the prior art work of another. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 534 (CCPA 1982) (holding preamble of Jepson-type claim to be admitted prior art where applicant's specification credited another as the inventor of the subject matter of the preamble). However, this implication may be overcome where applicant gives another credible reason for drafting the claim in Jepson format. In re Ehrreich, 590 F.2d 902, 909-910, 200 USPQ 504, 510 (CCPA 1979) (holding preamble not to be admitted prior art where applicant explained that the Jepson format was used to avoid a double patenting rejection in a co-pending application and the examiner cited no art showing the subject matter of the preamble). Moreover, where the preamble of a Jepson claim describes applicant's own work, such may not be used against the claims. Reading & Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984); Ehrreich, 590 F.2d at 909-910, 200 USPQ at 510.

abstraction of the art represented by Figures 6-8, part of the applicant's invention. By identifying deficiencies in the prior art and then addressing those deficiencies, applicant completes the inventive process. As such, applicant's effort to identify deficiencies or other undesirable features in the art, does not constitute "Prior Art" as that term is defined under 35 USC §103, and 35 USC §§102(a)-(g). This line of argument is not convincing. Again, nowhere in the specification does the applicant mention the subject matter of Fig. 6 is the applicant's own old machine which the disclosed and claimed improvement is based on in accordance with 37 CFR 1.183 (b)⁴. With regard to Figs. 7 and 8, repeating again, the applicant makes reference to a 1992 disclosure EP 1992 0850168 on page 2 of the specification, the 1992 disclosure EP 1992 0850168 clearly is considered to be prior art treatable under 35 USC §103 and 35 USC § 102.

Fourth, petitioner argues that the applicant has never made any statement which could be construed as a declaration against interest or an admission that Figures 6-8 were "Prior Art". Petitioner also argues that the applicant devised the subject matter of Figs. 6-8. The evidence lies in the fact that the only existence of Figures 6-8 are in the present application and its parent priority document Korean Application Serial No. 10-2003-0018745 filed on Mar. 26, 2003 and International Application No. PCT/KR04/000519 filed on Mar. 12, 2004. It is noted that nowhere in the specification does the applicant mention the subject matter of Figs. 6-8 was devised by the applicant. In the absence of another credible explanation in the specification, the examiner has treated Figs. 6-8 as the work of another. Not only is this proper, but the examiner would be remiss if he hadn't. If applicant is attributing the work to himself, attention is directed to affidavit practice under 37 CFR § 1.132 and MPEP 716.10.

Petitioner has exemplified other applications where decisions on petition have granted similarly raised objections as in the present application. Decisions on petition under 37 CFR § 1.181 are not precedential and are each decided on their own merit. See *In re The Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343; 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

Conclusion

For the foregoing reasons, the relief requested by petitioner will not be granted. Specifically, the examiner's objection to the drawings in the final Office action dated Apr. 10, 2007 is proper.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3732 to await a response from applicant to the Office action mailed Nov. 26, 2007. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

⁴ 37 CFR § 1.83 Content of drawing. (b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

The petition is dismissed.

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